

Remarks

Interview Summary

Applicant wishes to thank the examiner for the telephone interview of September 15, 2003. The items discussed during the interview are essentially those items presented below. The applicant and the examiner were unable to reach agreement. Accordingly, this amendment re-presents those arguments presented during the interview for the examiner's further consideration.

Amendments to the Claims

Upon entry of the foregoing amendment, claims 1, 3-16 and 18-20 are pending in the application. Of the pending claims, claims 1, 11 and 15 are independent. Claims 1, 11 and 15 have been amended to include a limitation with respect to the fluid communication channel. The amended claims all specifically require a fluid communication channel capable of performing the function of enabling fluid to flow from one inflatable compartment into the other inflatable compartment.

All of the claims include a limitation with respect to the fluid communication channel and more specifically require a fluid communication channel capable of performing the function of enabling fluid to flow from one inflatable compartment into the other inflatable compartment. As admitted by the examiner, the Boyd reference lacks this element and limitation. The examiner has cited Saltness as the motivation to modify the Boyd reference to provide a fluid communication channel between the first and second compartments of Boyd.

Initially, the examiner stated the motivation to modify Boyd was to maintain shape upon inflation. The communication channels of Saltness are part of a diaphragm that prevents the side panels from bowing outward as the device of Saltness is inflated. The channels provide fluid communication between the upper and lower portions of the cushion. A similar modification of the Boyd device to maintain shape upon inflation would be to provide a diaphragm with channels in the middle of the first or second compartments. The resulting modified Boyd device would not have all of the limitations of the claims with respect to a fluid communication channel between the first and second compartments.

The examiner has also stated that it would be obvious to modify the compartments of Boyd to have a fluid communication channel, as taught by Saltness, to allow free passage of fluid between the upper and lower sections. The examiner states that Saltness can be used as a teaching for a single fluid communication channel between the two compartments, but there is no discussion concerning why such a modification would be desirable (i.e. what reason, suggestion or motivation would cause one to make this modification?). As set forth in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000)

"every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant."

Absent such a reason, the only justification for the suggested modification is one based upon impermissible hindsight. As stated in the case of *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992):

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, (Fed. Cir. 1990).

In addition to the lack of motivation for the suggested modification set forth above, the suggested modification would destroy the intent, purpose or function of the Boyd device. As stated previously, the applicant is the owner and inventor of the Boyd device. As such, the applicant is uniquely qualified to state that the suggested modification would destroy the intent, purpose or function of his prior device. Placing a fluid communication channel between the first and second compartments of the Boyd device would prevent at least two of the objects of that invention.

As previously submitted, the suggested modification would prevent the upper compartment of Boyd from acting as an insulating layer. The examiner has taken exception to this argument and found it to be not persuasive. The argument is renewed here but not further discussed.

Other objects of the Boyd invention that are affected by the suggested modification is the ability to easily adjust the feel of the mattress as set forth in column 1, lines 32-41 and to provide separately adjustable zones as described in column 1,

lines 58-59. The examiner previously did not address this argument. A fluid communication channel as suggested between the first and second compartments of Boyd would allow additional air added to the upper compartment to freely flow to the lower compartment. Thus, to adjust the feel of the mattress, one would have to add enough air to the entire system to change the feel. This would not be as easy as adding air to only the upper compartment (that has a smaller volume than the combined upper and lower compartment system created by the modification). In addition, the inclusion of a fluid communication channel between the compartments would not allow the Boyd device to have separately adjustable zones. Air added to one zone would flow through the new fluid communication channel such that no zone could be adjusted to feel different from another zone. Because the suggested modification would destroy the intent, purpose or function of the Boyd device, it would not be obvious to one of ordinary skill in the art to make the suggested modification and the rejection should be withdrawn.

Conclusion

Accordingly, Applicants respectfully submit that independent claims 1, 11 and 15 are allowable over the prior art of record. For similar reasons, Applicants urge that the dependent claims are also allowable.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office

Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



David R. Deal, Reg. #48204
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6531
Fax: 314-552-7531